REMARKS

35 U.S.C. §101 R jections

The Examiner rejected claims 39-49 under 35 U.S.C. §101 asserting that the claims lack utility because they appear to address subject matter that violates public policy, specifically, Title 42, Section 1302a-7b of the United States Code. Claims 39-49 have been cancelled without prejudice, and replaced by claims 50-71. The claims as set forth are not illegal, not against public policy, and as such, are not contrary to §101. Applicant respectfully traverses the rejection.

The Examiner contends that the claimed invention opposes public policy, and thus, constitutes an illegal method of business. Applicant disagrees. The claimed invention is directed to a medical care provider that receives compensation for a prescribed medical supply ordered from a website associated with the prescribing medical care provider. It is important to distinguish, however, between what the claimed invention is and how someone might choose to illegally practice the claimed invention.

The claimed invention encompasses an embodiment in which the prescribing medical care provider may own the website referred to in the claims. In this case, the claimed invention is legal in the United States. Additionally, other scenarios exist that are not impacted by, or do not involve, the statute cited by the Examiner. In one example, a medical care provider who has entered into a business relationship with a medical supply vendor, even if it is a separate company, can legally practice the claimed invention. In another example, a medical care provider may legally practice the claimed invention within the confines of one or more of the "Safe Harbors" specifically identified by Congress that shelter commonplace business arrangements within the healthcare industry from criminal and/or civil prosecution. 42 U.S.C. §1320a-7(b)(3)(C) lists several such Safe Harbors in which remuneration is *not* prohibited by law as long as specific criteria are met

Finally, not all health care programs fall under the regulatory umbrella of 42 U.S.C. §1320a-7b. Indeed, 42 U.S.C. §1320a-7(f) is explicit in its definition of a Federal health care program, and it only includes plans or programs funded directly or indirectly by the U.S. government (e.g., Medicare, Medicaid). The statute cited by the Examiner to support the rejection does not appear applicable to products and/or services reimbursable by either *private* commercial insurers or patients who pay for medical supplies and/or services out-of-pocket. Even the definition of a Federal health care program particularly identifies at least one health insurance program that appears exempt from the statute.

As long as there is *any* legal application, the claimed invention cannot be rejected under 35 U.S.C. §101. Indeed, a firearm is patentable subject matter even though it can be used to murder. However, when wielded in self-defense, it does serve a useful purpose, and is legal (see e.g., *Ex parte Murphy*, 200 USPQ 801). This is not a case where the claimed business method is illegal per se on its face, and thus, the claims cannot be rejected under §101. Accordingly, Applicant respectfully requests the withdrawal of the §101 rejection.

35 U.S.C. §102(e) Rejections

The Examiner maintained the rejection of claims 32-38 under 35 U.S.C. §102(e) as being anticipated by Silver. While Applicant has cancelled these claims, each new independent claim 50, 62, and 68 explicitly requires "the medical care provider that prescribed the medical supply [to receive] payment for the medical supply ordered from the website associated with the medical care provider." Thus, the medical care provider receives compensation for the prescribed medical supply ordered from the website *after* a medical examination has been conducted and *based on the results*.

The Examiner contends that the subscription fees of Silver received by the doctor teach this limitation. However, a fee paid to access a system does not teach, nor does it even suggest, compensation received *after* a medical examination has been conducted and *based on*

the results. The subscription fees of Silver equate to nothing more than "membership dues" that are merely a pre-requisite to accessing a "questionnaire". Indeed, Silver explicitly teaches that the user cannot begin to use the system if he/she is not a paid subscriber. *See* Figure 1; col. 8., ll. 41-51. There is no evidence whatsoever that the doctor in Silver receives any compensation from the purchase of a prescribed medical supply, and the Examiner never purports that there is.

Additionally, new claims 50 and 62 each explicitly require that a *medical care provider "conduct a medical examination* on a patient...[and *prescribe* a] medical supply for the patient...*based on the results of the medical examination*." The Examiner contends that the questionnaire of Silver teaches the claimed "medical examination," and that the suggested lifestyle modifications that result from the questionnaire teach the claimed "prescribing a medical supply."

Assuming *arguendo* that the Silver patent supports these assertions (which it does not), then the Examiner's reasoning necessarily equates the computer system of Silver with the claimed medical care provider. Applicant defines the meaning of "medical care provider" on page 3 of the specification, lines 18-21. "The disclosure will speak in terms of the medical care provider being a doctor, but it should be appreciated that other medical professionals such as nurse practitioners, physician assistants, chiropractors, or the like may all fall under the title medical care provider." Applicant does not include a computer system in the definition, and as such, a computer cannot be labeled a "medical care provider" as Applicant uses that term in the claims. Anyone skilled in the art, and indeed many who are not, readily appreciate that a computer is not a medical care provider. This is true in view of the plain meaning of the term, as well as in view of Applicant's explicit definition.

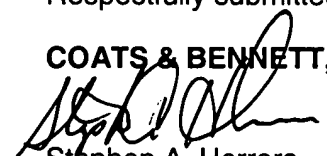
If the computerized system of Silver cannot conduct the requisite medical examination, then it necessarily follows that it cannot prescribe a medical supply for the patient based on the results of the medical examination. Applicant's specification clearly defines the meaning of the

term "prescribe" on page 4 of the specification, lines 3-4. "...as used herein 'prescribe' shall be interpreted as 'to designate or order the use of as a remedy.'" Thus, specific orders are directed to a specific patient by a medical care provider – not a computer - resulting from a medical examination. The recommendations of Silver, however, have no such specificity. In sharp contrast, they are merely canned suggestions based on a set of predetermined rules and answers to a set of pre-programmed questions provided by a user. In other words, the system of Silver makes a "best guess" to lump users into "probability" groups, and uses information about these groups to make a suggestion – a suggestion that may or may not be accurate for any number of members in the group.

Indeed, the Examiner has afforded the claim elements an unreasonably broad interpretation. The Silver patent fails to teach that the doctor receives any compensation for the ordered medical supply. Further, no person skilled in the art would ever consider a computer system to be a "medical care provider," nor would they equate a pre-programmed set of questions displayed on a computer with a medical examination conducted by a medical care provider. Moreover, no one skilled in the art would ever consider a set of common sense suggestions (i.e., quit smoking) displayed by a computer to even suggest prescribing a medical supply. Accordingly, because the Silver patent fails to teach each and every element of the independent claims, it necessarily fails to anticipate the claims under §102. Thus, Applicant respectfully requests the allowance of claims 50-71.

Respectfully submitted,

COATS & BENNETT, P.L.L.C.

By: 

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Date: August 11, 2003